

REMARKS

Claims 1-25 are pending. The Office Action dated June 10, 2003 has been carefully reviewed. Reconsideration of the grounds of rejection is respectfully requested in view of the remarks herein.

Summary of the Office Action

References to paragraphs in the subject office action are referred to herein in parentheses identifying the appropriate paragraph, e.g. (para x).

Claims 1-17 and 20-25 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,078,866, issued to Buck et al. ("Buck"), in view of U.S. Patent No. 6,553,367, issued to Horovitz et al. ("Horovitz") (para 3).

Claims 18 and 19 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over, U.S. Patent No. 6,078,866, issued to Buck et al. ("Buck"), in view of U.S. Patent No. 6,553,367, issued to Horovitz et al. ("Horovitz") and further in view of U.S. Patent No. 6,339,644, issued to O'Neil et al. ("O'Neil") (para 4).

Response to Office Action

A. Rejection of Claims 1-17 and 20-25

In response to the Examiner's rejection of claims 1-17 and 20-25, the Applicants respectfully assert that the pending claims are allowable over the cited references because the Examiner has failed to establish a *prima facie* case of obviousness. The MPEP states, in relevant part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2142.

Buck and Horovitz fail to teach or suggest, either alone or in combination, all of the claim limitations of claims 1-17 and 20-25.

1. Rejection of Claims 1, 21, 22 and 23

Claim 1 is directed to a method of providing news relating to a specified subject to a subscriber. The method is comprised of the following steps: electing a plurality of Web sites operated by content providers and relating to a category to which the specified subject relates; automatically determining the relevancy of at least one Web page in each selected Web site by scanning at least one Web page for words relating to the specified subject; automatically determining the content type of at least one Web page in each selected Web site by scanning at least one Web page for words indicating content type; compiling a list of relevant Web pages based only on the results of steps (b) and (c); and providing the compiled list to the subscriber, wherein the subscriber is a party other than one of said content providers. The Applicants respectfully submit that Buck and Horovitz, alone or in combination, fail to teach the underlined features set forth in the above paragraph.

Buck discloses a denominated-value search method and system for Internet searching and indexing where the listings in the search report are ranked by “value (\$) as paid by the listing subscriber.” Buck, Col. 3, lines 53-54; Col. 5, line 63-65. The ranking is proceeded by an “index search 20 and/or category search 30.” Buck, Col. 5, lines 66-67. The index search is performed by searching “content on the Web and indexes them according to certain targeted keywords and other factors.” Buck, Col. 5, lines 47-49. To create the category and subcategory menus, the “site listing submissions are reviewed and assigned to selected categories.” Buck, Col. 5, lines 49-51.

The Examiner has also cited Horovitz which discloses a method and system for creating and searching “a unified classification information graph.” Horovitz, Col. 2, line 56. The unified classification information graph is used to graphically represent information from multiple sources, in particular on-line catalogs. The user first creates a graphical representation, “LinkGraph,” of a single on-line catalog. The LinkGraph appears like “a mesh of nodes and edges.” Horovitz, Col. 5, lines 34-36. The user then connects all of the different LinkGraphs, of the various on-line catalogs, to generate a ClassificationGraph (“UCIG”). Horovitz, Col. 6, line 44- Col. 7, line 36. The user may then use system to search the UCIG for a desired product among all the on-line catalogs.

In regards to the claim 1 limitation of “compiling a list of relevant Web pages based only on the results of steps (b) and (c),” the Examiner has cited Horovitz, Col. 7, lines 37-49 which states:

A Node Connection goal is that a UCIG node should be connected to LinkGraph nodes that have access to product information matching the UCIG node category. If the LinkGraph node accesses product pages such that only part of them match the UCIG node category, then we use Positive and Negative filters in order to filter products, and retrieve only the products relevant to the category. For example, a UCIG node with a category "586 laptop" will be connected--using a LinkGraph node connection--to all LinkGraph nodes that contain products of this type. (underlining added for emphasis.)

The Applicants submit this passage of Horovitz refers to searching for products in on-line catalogs via the nodes and edges of a UCIG and LinkGraph. As described in Col. 5, lines 31-45 of Horovitz, a node represents an HTML page and an edge represents an HTML hyperlink to another HTML page where the page is a product page of an on-line catalog. A node is indicated by the basic form of (Text, URL) where Text “is the text appearing on the user’s browser as the hyperlink name” and URL “is the address of the page to be accessed when the user selects this hyperlink.” Col. 5, lines 40-42; Col. 6, line 46. The Applicants assert that filtering for a product

based on a hyperlink name or URL is not the same as compiling a list of relevant Web pages based on the contents and relevancy of a Web page determined by scanning a Web page for words indicating content and scanning a Web page for words related to a specified subject.

Therefore, Horovitz does not disclose, teach or suggest the “compiling a list” step of claim 1 nor does Buck make up for this deficiency as admitted by the Examiner. The Applicants respectfully submit that Buck and Horovitz fail to show, either alone or in combination, all of the claim limitations of claim 1. Likewise Buck and Horovitz fail to show, either alone or in combination, all of the claim limitations of claims 21, 22 and 23 which include the same claim limitations as claim 1.

2. Rejection of Claim 7

Claim 7 is directed to a method of providing news related to a specified subject to a subscriber. The method is comprised in part by the step of: “wherein the plurality of Web sites is selected based on the frequency with which relevant links have been located in prior iteration of the method with respect to the specified subject.” The Applicants assert that the passage of Horovitz, cited by the Examiner, (Col. 5, lines 31-49) describes the formation of a LinkGraph as discussed above. The cited passage of Horovitz, furthermore, does not even mention selecting web sites based on the frequency of locating links in prior search iterations. Horovitz, in contrast, describes including a web site in the LinkGraph of Horovitz based on the listing of products from on-line catalogs. Thus, Horovitz fails to disclose each and every element of claim 7 or its equivalent. Nor does Buck make up for this deficiency. For this and the reasons noted above, for independent claim 1, claim 7 is allowable.

3. Rejection of Claims 2-6, 8-17 and 20

Claims 2-6, 8-17 and 20 depend directly or indirectly from independent claim 1. Therefore, for the reasons note above claims 2-6, 8-17 and 20 are allowable because such claims depend from an allowable base claim.

4. Rejection of Claims 24 and 25

The Applicants respectfully assert that claims 24 and 25 are patentable over Buck in view of Horovitz. For the reasons noted above, Buck and Horovitz fail to show, either alone or in combination, the claim limitation for step (d) of “compiling a list of relevant Web pages based on the results of steps (b) and (c)” of claims 24 and 25.

The Examiner has cited Col. 5, lines 43-61 of Buck as disclosing the claim 24 limitation for step (d) of “wherein the list of relevant Web pages includes only those Web pages that are determined both to be relevant in step (b) and to be of a news content type in step (c).” This cited section of Buck provides in part: “The search report may rate the listings by a relevancy ranking, computed on the basis of certain relevancy factors selected by the search service.” The Applicants submit that rating a listing from a search report by relevancy is not the same as compiling the list of relevant web pages including only those that are both relevant and contain news content. In fact, Buck does not even discuss news content. Nor does Horovitz make up for this deficiency.

Furthermore, the Examiner has cited Col. 6, lines 12-32 as disclosing the claim 25 limitation for step (d) of “wherein the list of relevant Web pages includes only those Web pages that are determined both to be relevant in step (b) and not to be advertisements in step (c).” The passage of Buck, cited by the Examiner, discloses search results that are sorted and displayed based on “denominated value” which is the “dollar amounts paid for subscription fees” to the

search service. Col. 6, lines 21-22. The Applicants respectfully assert that the cited passage in Buck, does not contain a single reference to compiling a list of relevant Web pages where list is based on relevancy and the content is not advertisements. In fact, the cited passage from Buck contains no reference to ranking search results based on relevancy, and it does not contain any reference to ranking search results based on content other than advertisements. Furthermore, as stated the Applicant's Response to Official Action, dated May 12, 2003, this passage of Buck discloses a compiled list based on a dollar amount paid by the content provider to the searching service. Nor does Horovitz make up for this deficiency.

B. Rejection of Claims 18 and 19

The Applicants respectfully assert the Examiner has failed to establish a *prima facie* case of obviousness and claims 18 and 19 are, therefore allowable over the cited references.

The Examiner has cited O'Neil for disclosing the providing Web pages via "an intranet" and via "wireless communication" as required by claims 18 and 19, respectively. The cited passage of O'Neil discloses a system coupled via a "wireless" network and a network that is a combination of a "LAN, WAN, intranet, Internet, telecommunication, or specialty network." O'Neil, Col. 15, lines 20-24.

Claims 18 and 19, however, depend from independent claim 1 which is patentable over Buck and Horovitz for the reasons noted above. Furthermore, O'Neil fails to disclose any of the limitations that are not disclosed in Buck and Horovitz, as discussed above, but are required by claims 18 and 19. The Applicants submit that claims 18 and 19 are allowable because they depend directly from an allowable base claim.

CONCLUSION

In view of the foregoing remarks, it is submitted that pending independent claims 1, 21, 22, 23, 24, and 25 are in condition for allowance. In addition, it is submitted that dependent claims 2-20 are allowable, because such claims depend from an allowable base claim. Accordingly, reconsideration and allowance of claims 1-25 are requested.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections presented in the Office Action mailed June 10, 2003. The Examiner is invited to contact the undersigned at 215-963-5055 to discuss any matter concerning this Application.

The Commissioner is hereby authorized by this paper to charge any fees due in connection with the filing of the response to Deposit Account No. **50-0310**.

Respectfully submitted,

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Date

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